

REMARKS

Claims 34 and 36-46 are pending within the present application. All of the pending Claims have been amended to reflect the limitation that the inventive films are extruded types, as indicated in the first full paragraph of page 6 and the last full paragraph on page 9 of the originally filed specification. No new matter has been added. As Applicant has requested such amendments in an earnest attempt to place this application in condition for allowance, entry and due consideration thereof are respectfully solicited. No Claims have been cancelled or added.

It is further noted that previous status lists of the pending claims inadvertently omitted Claim 36 as pending. However, no cancellation of such a claim has been found upon review of the prosecution history to date. Thus, it appears that such a claim should be considered pending. Applicants regret any confusion related to their presentation of the status of the pending claims in previous communications.

The Office has rejected claims 34 and 37-46 under 35 U.S.C. § 103(a) as being unpatentable over Krall et al. in view of JP 09002537. Applicants respectfully, though vehemently, disagree with the basis of this rejection, specifically because neither reference teaches a polyurethane film that includes any antimicrobial compounds, let alone those currently claimed, that are embedded within a film to the same extent as now claimed. Krall et al. are directed to the manufacture of thick sheets of plastics, including polyurethanes, that are formed from polyurethane pellets. These pellets are formed through the initial production of a polyurethane film, the subsequent coating of the film

with an antimicrobial, the subsequent comminuting and melting down of the coated film,
and finally extruding that molten resin into thick sheets that cool into the desired shape
and article (see the Example on cols. 10 and 11). There is no teaching anywhere within this reference of the co-extrusion of any polyurethane resin with an antimicrobial to form a thin film of the same thickness as now claimed. The Office has clearly misread this reference and is using Applicants' own teachings against them as an exercise of improper hindsight reconstruction of their own invention. The secondary reference teaches nothing concerning films of any kind but thick parts (which are the same, basically, as the ultimate parts taught within Krall et al. which would include embedded antimicrobials) and thus provides no help in providing motivation to the ordinarily skilled artisan with a direction to take in terms of providing embedded antimicrobials within thin films. In essence, this rejection is clearly improper and fails to meet the required standard of teaching Applicants' "invention as a whole", Jones v. Hardy, 220 USPQ 2d 1021, 1025 (Fed. Cir. 1984). There are simply no thin films with embedded antimicrobials taught or implied within any of the cited references. Reconsideration and withdrawal of such an improperly based rejection are therefore earnestly solicited.

The Office has also rejected all of the pending claims under 35 U.S.C. § 103(a) as being unpatentable over JP 11-028797 in view of JP 09002537. The primary JP reference, like Krall et al., above, simply fails to teach any extruded antimicrobial-embedded thin films as now claimed, regardless of the type of antimicrobial used. To the contrary, this reference teaches a polyurethane resin molding having a polyurethane paint applied to its surface with antimicrobial components included within the paint

composition. The resultant composite is a thick resin molding with a painted-on and cured polyurethane laminate applied thereto. There is no teaching of any stand-alone extruded film with embedded antimicrobials therein, let alone antimicrobials that extend outward from the surface thereof, as now claimed. The prior art film is not extruded nor would it exist on its own without the resin molding substrate within the primary JP reference's disclosure. In fact, the manner of manufacture involved dip-coating the base resin molding in a polyurethane solution, and thereafter curing to form a coating on the base article. As such, it is respectfully submitted that this reference is inapplicable to the problems solved by the currently claimed invention.

The secondary reference, additionally, fails to remedy this problem as the patentees are limited in scope of their teachings to antimicrobials for plastic articles, much like the base resin molding by itself within the primary JP reference. There is no suggestion that an extruded thin film may be produced with any antimicrobials within this secondary reference. As in the above rejection, the combination of references in this situation simply fail to teach Applicants' "invention as a whole" as is required for a proper obviousness-based rejection. Retention of this same basis of rejection over the newly amended claims would thus be a clear exercise of improper hindsight reconstruction of Applicants' own teachings. Reconsideration and withdrawal of such bases of rejection over the amended claims are therefore earnestly solicited.

CONCLUSION

In view of all of the previous amendments and arguments, it is respectfully requested that the preceding amendments and remarks be entered and duly considered, all of the prior rejections of the present claims be withdrawn, and this application be passed on to issue.

Respectfully submitted,

September 25, 2003



William S. Parks
Attorney for Applicants
Registration Number 37, 528
Telephone: (864) 503-1537

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as "Express Mail" Identification number EL992174251US in an envelope addressed to Mail Stop Patent Application, The Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on September 25, 2003, along with the a Post Card Receipt.



William S. Parks, Attorney for Applicants